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10/798,697	03/10/2004	Rajendra A. Bopardikar	42P18003	6164

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EXAMINER

BATURAY, ALICIA

ART UNIT	PAPER NUMBER
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2155

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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**Office Action Summary**

Application No.

10/798,697

Applicant(s)

BOPARDIKAR ET AL.

Examiner

Alicia Baturay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

1. Claims 1-20 are presented for examination.

#### *Specification*

2. The specification is objected to because of the following informalities: On page 2, line 12, Applicant states "By digital home is often meant" It is believed Applicant meant to write "By digital home *it* is often meant" Additionally, on page 8, paragraph 20, Applicant states "Transcoding is the technique of converting a media file from one format to another" twice. It is suggested that the second recitation of this sentence of the paragraph be deleted. Further, on page 11, line 12 Applicant states "It will be appreciated that MPEG and *WM* formats" It is thought Applicant meant to write "It will be appreciated that MPEG and *WMV* formats." These corrections are exemplary and further corrections within the specification are required.

#### *Claim Objections*

3. Claim 1 is objected to because of the following informalities: lines 2-3 state "a storage medium comprising machine-readable instructions stored thereon to:" In the interest of more clearly stating which statutory category of invention this claim fits into based upon the preamble, the examiner recommends deletion of the colon following the "to" on line 2. Appropriate correction is required.

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***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 6, 7 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The use of the word “system” does not inherently mean that the claim is directed toward a machine. Only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed to constitute part of a device or a combination of devices to be a machine. In this claim, the recitation of “system” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In claim 6, Applicant claims a system with software modules but does not define within the body of the claim the hardware in which the invention runs. The home media network server and discoverable home network transcoder server are interpreted as a software program as described in the specification on page 10, paragraph 26, and the home network media renderer is interpreted as a module in a web browser as described in the specification on page 7, paragraph 17. All of these elements within the body of the claim may reasonably be

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implemented as software routines, and thus what is claimed is essentially a system of software per se which fails to fall into a statutory category of invention.

It is noted that claims 8 and 10 are not included in this rejection because they further define the home network media renderer as hardware.

The examiner encourages Applicant to define within the claims the embodied features and limitations on computer readable media such as hard drives, disks, and other hardware elements.

6. Claims 11-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 11, Applicant claims a server with software modules but does not define within the body of the claim the hardware in which the invention runs. The home network transcoder server is interpreted as a software program as described in the specification on page 10, paragraph 26, and the input, output and circuitry are interpreted as software, as described in the specification on page 16, paragraph 40. All of these elements within the body of the claim may reasonably be implemented as software routines, and thus what is claimed is essentially software per se which fails to fall into a statutory category of invention.

The examiner encourages Applicant to define within the claims the embodied features and limitations on computer readable media such as hard drives, disks, and other hardware elements.

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*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ramaswamy et al. (U.S. 2006/0242325).

9. With respect to claim 1, Ramaswamy teaches an article comprising:

A storage medium comprising machine-readable instructions stored thereon to: execute a discoverable home network transcoder server (Ramaswamy, Fig. 1, reference numeral 22; page 2, paragraph 15) to communicatively couple to a media server to receive media signals from the media server (Ramaswamy, Fig. 1, reference numeral 24; page 2, paragraph 16), to convert the media signals to a format compatible with more than one media renderers, and to transmit the converted signals to the more than one media renderers (Ramaswamy, page 3, paragraph 24).

10. With respect to claim 2, Ramaswamy teaches the invention described in claim 1, including the article wherein the more than one media renderers comprise media renderers selected from the group consisting of a speaker, a video display, a video display/speaker combination, a flat panel monitor, a liquid crystal display screen, an audio speaker, a plasma

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screen television display, and a high definition television display (Ramaswamy, page 1, paragraph 13).

11. With respect to claim 3, Ramaswamy teaches the invention described in claim 1, including the article wherein the discoverable home network transcoder server further comprises a transrating module (Ramaswamy, page 4, paragraph 27; Fig. 5A, reference numerals 90 and 92 and Fig. 5B, reference numerals 120 and 122; page 4, paragraphs 29-30).

12. With respect to claim 4, Ramaswamy teaches the invention described in claim 1, including the article wherein the discoverable home network transcoder server comprises a software module to execute on the media server (Ramaswamy, Fig. 1, reference numeral 24; page 2, paragraph 16 and page 5, paragraph 34).

13. With respect to claim 5, Ramaswamy teaches the invention described in claim 4, including the article wherein the software module further comprises a transrating module (Ramaswamy, page 4, paragraph 27; Fig. 5A, reference numerals 90 and 92 and Fig. 5B, reference numerals 120 and 122; page 4, paragraphs 29-30).

14. With respect to claim 6, Ramaswamy teaches a system comprising:

A home network media server that provides signals representing media content (Ramaswamy, Fig. 1, reference numeral 24; page 2, paragraph 16); at least one home network media renderer communicatively coupled to the home network media server that

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receives the signals representing the media content (Ramaswamy, Fig. 1, reference numeral 12; page 1, paragraph 13); a discoverable home network transcoder server communicatively coupled to receive the signals representing the media content from the home network media server, to convert the signals representing the media content to a format compatible with the at least one home network media renderer, and to transmit the converted signals to the at least one home network media renderer (Ramaswamy, Fig. 1, reference numeral 22; page 2, paragraph 15); and at least one antenna for communicating between the discoverable home network transcoder server and the at least one home network media renderer (Ramaswamy, page 2, paragraph 17).

15. With respect to claim 7, Ramaswamy teaches the invention described in claim 6, including the system wherein the media content is selected from the group consisting of audio content, video content, and picture content (Ramaswamy, page 1, paragraph 13).
16. With respect to claim 9, Ramaswamy teaches the invention described in claim 6, including the system wherein the at least one home network media renderer comprises a plurality of media renderers (Ramaswamy, Fig. 1, reference numerals 12; page 1, paragraph 13).
17. With respect to claim 11, Ramaswamy teaches a home network transcoder server comprising:



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An input for receiving media signals from a media server in the home network (Ramaswamy, page 3, paragraph 24); circuitry for transcoding the media signals received at the input; an output for providing transcoded signals back to the media server, the circuitry to transparently convert the media signals to a format compatible with at least one media renderer, and the circuitry to transmit the converted signals to the at least one media renderer (Ramaswamy, page 4, paragraph 27).

18. With respect to claim 12, Ramaswamy teaches the invention described in claim 11, including the home network transcoder server further comprising a circuitry for transrating the media signals from the media server (Ramaswamy, page 4, paragraph 27; Fig. 5A, reference numerals 90 and 92 and Fig. 5B, reference numerals 120 and 122; page 4, paragraphs 29-30).

19. With respect to claim 13, Ramaswamy teaches the invention described in claim 11, including the home network transcoder server comprising a program for both transcoding and transrating the media signals that are received from the media server (Ramaswamy, page 4, paragraph 27; Fig. 5A, reference numerals 90 and 92 and Fig. 5B, reference numerals 120 and 122; page 4, paragraphs 29-30).

20. With respect to claim 14, Ramaswamy teaches the invention described in claim 11, including the home network transcoder server wherein the circuitry for transcoding media

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signals received from the media server comprises circuitry from the media server (Ramaswamy, page 5, paragraph 34).

21. With respect to claim 15, Ramaswamy teaches a method comprising:

Incorporating a home network media renderer by a client of a home network, the client being a module in a web browser having a network application program that supports a first media file format for the home network media renderer (Ramaswamy, page 4, paragraph 26); encoding the home network media renderer in the first media file format to support media files of the first media file format (Ramaswamy, page 4, paragraph 28); requesting from a media server with the network application program of the client a media file of a second media file format (Ramaswamy, page 4, paragraph 26); and recognizing with a discoverable home network transcoder server that the media file is of the second media file format and converting the home network media renderer of the network application program to the second media file format prior to providing the media file to the web browser module of the client (Ramaswamy, page 4, paragraph 27).

22. With respect to claim 16, Ramaswamy teaches the invention described in claim 15, including the method wherein the client comprises a graphical user interface to contact the media server (Ramaswamy, page 4, paragraph 26).

23. With respect to claim 17, Ramaswamy teaches the invention described in claim 15, including the method wherein said incorporating the home network media renderer by the

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client comprises providing a list of available media renderers and selecting the home network media renderer from the list of available media renderers (Ramaswamy, page 4, paragraph 28).

24. With respect to claim 18, Ramaswamy teaches the invention described in claim 17, including the method further comprising converting the selected home network media renderer to recognize the first media file format prior to passing the home network media renderer to the client (Ramaswamy, page 4, paragraph 27).

25. With respect to claim 19, Ramaswamy teaches a method comprising:

Emulating a discoverable home network transcoder server for communicatively coupling to a media server to receive media signals from the media server, to transparently convert the media signals to a format compatible with at least one media renderer, and to transmit the converted signals to the at least one media renderer (Ramaswamy, page 2, paragraph 15).

26. With respect to claim 20, Ramaswamy teaches the invention described in claim 19, including the method further comprising the transcoder server further emulating a transrating module (Ramaswamy, page 4, paragraph 27; Fig. 5A, reference numerals 90 and 92 and Fig. 5B, reference numerals 120 and 122; page 4, paragraphs 29-30).

27. Claims 8 and 10 do not teach or define any new limitations above claim 2 and therefore are rejected for similar reasons.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay  
January 16, 2008

  
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SUPERVISORY PATENT EXAMINER